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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,005	09/12/2000	Thomas E. Saulpaugh	5181-66200	6061

7590 02/28/2006

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EXAMINER

THOMPSON, MARC D

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/660,005	Applicant(s) SAULPAUGH ET AL.	
	Examiner Marc D. Thompson	Art Unit 2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 21-28 is/are rejected.
- 7) ☒ Claim(s) 18-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20010813, 20050124, 20050210</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been reassigned to a new Examiner. See Conclusion section below, for new Examiner contact information.
2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. The request for reconsideration, received 9/6/2005, has been entered into record, and has found to be persuasive.
3. Claims 1-28 remain pending.

Priority

4. This application claims priority to various provisional applications. The effective filing date for those claims which do not have proper support in their provisional application is 9/12/2000.

Terminal Disclaimer

5. The terminal disclaimer received on 1/10/2005 has been entered into record and accepted. Any term beyond the term of U.S. Patent Number 6,792,466, is disclaimed.
6. After cursory review of a number of copending applications and patents having common inventors (literally, hundreds), no other double patenting rejections are deemed appropriate at this time. If Applicant is aware of other applications which share similar or identical subject matter with the presently claimed invention, Applicant is requested to supply identification of such documents.

Drawings

7. The Examiner contends that the drawings submitted on 9/12/2000 are acceptable for examination proceedings.

Information Disclosure Statements

8. The PTO-1449 IDS statements submitted by Applicant on 8/13/2001, 1/24/2005, and 2/10/2005, have been considered.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 27 and 28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, the claimed invention lacks patentable utility, and the disclosed invention is inoperative and therefore lacks utility.

11. Claims 27 and 28 recite “a tangible computer accessible medium comprising...” in the preamble of the claims.

1. There is no suitable definition as known in the art to ascertain what this limitation is specifically referring to. Additionally, what constitutes a “computer accessible medium” is at question, irregardless of any tangibility. Further, being “tangible” is not enough to warrant statutory conformance. See, inter alia, MPEP 2106. Also, the use of the adjective(s) “computer accessible” does not provide sufficient detail to interpret the claimed invention as a functional component of an operational system.

Art Unit: 2144

2. Even if it is presumed that the claimed “computer accessible medium” actually is “tangible” (that is, the computer accessible medium can be touched or perceived), the claimed apparatus does not perform any functions, cause functional state change of any given real world object such as machinery or computing equipment, or otherwise DO anything. Minimally, even though the computer accessible medium is presumed to be a physical, tangible object, it is not required to interact with computers at all. Thus, it is reasonable to consider this interpretation as software (programmatic functional behavior), per se, which has been held non-statutory. See, inter alia, MPEP 2106.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claims 27 and 28 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

14. Claims 27 and 28 recite “a tangible computer accessible medium comprising...” in the preamble of the claims. Nowhere in the specification is a definition provided to define what a “tangible computer accessible medium” encompasses. One skilled in the art at the time of invention would not be able to make and use the invention without undue experimentation since a suitable definition for what is being claimed and described in the specification is not provided.

Art Unit: 2144

Further, since the claims also exhibit a lack of utility under 35 U.S.C. 101, one skilled in the art clearly would not know how to use the claimed invention.

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 1-7, 12, and 25-28 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

17. Claim 1 recites “computer executable code built in to said device” in Line 5-6 of the claim. It is unclear what this limitation is attempting to describe. This limitation fails to qualify how code is “built in” to a given device, and what constitutes executable code being “built in” to an arbitrary device”. There is no readily available interpretation which distinguishes or specifies what is being claimed, including pure hardware, pure stored software, hardware containing software (e.g., integrated/flashable circuit boards), the installation of software on existing hardware, the use of volatile or non-volatile memory storage, or any other embodiment which executes computational methodologies, rendering the claim(s) indefinite.

18. Claims 12, 25 and 26 contain the trademark/trade name “Java”. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves.

Art Unit: 2144

Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a specific, evolving subset of the C++ programming language, and, accordingly, the identification/description is indefinite.

19. Claims 27 and 28 recite “a tangible computer accessible medium comprising...” in the preamble of the claims. It is unclear what this limitation is attempting to describe since no ascertainable metes and bounds can be properly determined. Further, there is insufficient antecedent basis for this limitation in the claim, since the specification never recites any definition(s) for “a tangible computer accessible medium”.

Claim Rejections - 35 USC § 102

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

21. Claims 1-4, 8-17, and 21-28 are rejected under 35 U.S.C. §102(e) as being anticipated by Roberts et al. (U.S. Patent Number 6,560,633), hereinafter referred to as Roberts.

22. Roberts disclosed message endpoint construction (inter alia, Column 4, Lines 30-31) in a distributed computing environment (inter alia, Column 2, Lines 35-43) where a pre-generated message interface was defined (inter alia, Column 5, Lines 47-55) to link a service address to a

Art Unit: 2144

defined message endpoint directive (inter alia, Column 4, Lines 34-38). The message endpoint schema(s) were well known and defined within the boundaries of the XML specification. See, inter alia, Column 4, Lines 12-20. Roberts web service applications (WSA) provided access control and interface definitions to application services. See, inter alia, Column 4, Lines 34-38. Further, Roberts disclosed run-time models (RTM) which served to define the process of the distributed application process. See, inter alia, Columns 7-8. Service calls were described to invoke application processes including reference to any corresponding WSA. See, inter alia, Column 9, Lines 1-8. The use of Java for WSA construction (Column 11, Lines 11-15) as well as XML based messaging (Column 16, Lines 20-24) were fully disclosed. Lastly, since services were available on the network, and unique addressing/specification/designation of every service was inherent in order for the service to be called, and messaging was fully enabled using XML documents defining both incoming and outgoing format(s) for services, the linking of address(es) to a given pre-generated messaging interface was present.

Claim objections

23. Claims 5-7 and 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and additionally remedied to overcome issues raised under 35 U.S.C. 112, second paragraph.

Response to Arguments

24. The arguments presented by Applicant in the response, received on 9/6/2005, are not considered persuasive in regard to patentability.

25. Applicant argues the prior art did not expressly teach the use of pre-generated message interfaces. It is submitted that these defined message interfaces were expressly provided by Roberts, inter alia, in Column 4, Lines 37-38 (interface definition). Further, these interfaces were available for each service, converting requests and responses into appropriate formats for various services and applications. See, inter alia, Column 4, Lines 27-30.

26. Applicant argues that the prior art of record fails to disclose or suggest the linking of addresses to pre-generated message interfaces. It is submitted that since Robert disclosed WSA modules which provided access control and interface definitions to application services, this limitation was fully taught. See, inter alia, Column 4, Lines 36-38.

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc D. Thompson whose telephone number is 571-272-3932. The examiner can normally be reached on Monday-Friday, 9am-4pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, David Wiley can be reached at 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned has recently changed, and is now 571-273-8300.

Art Unit: 2144

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MARC D. THOMPSON
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PRIMARY EXAMINER

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Art Unit 2144